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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,051	10/30/2003	Brian R. Reynolds	1001.1716101	1188

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EXAMINER	
HOEKSTRA, JEFFREY GERBEN	
ART UNIT	**PAPER NUMBER**
3736	

MAIL DATE	DELIVERY MODE
06/30/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/699,051	**Applicant(s)** REYNOLDS ET AL.	
	Examiner JEFFREY G. HOEKSTRA	**Art Unit** 3736	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-12,21,22 and 24-31*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736

/Jeffrey G Hoekstra/
Examiner, Art Unit 3736

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues the anticipatory rejection of the claims under Sharrow set forth in the Final Office Action mailed 04/10/08. The Examiner maintains the rejection of the claims in light of the clarifying amendments thereto and notes the following in response to arguments thereagainst:

Applicant argues "no discussion was presented in the Office Action indicating what portions of Sharrow were relied upon on teaching the limitations of claims 24-31", the Examiner directs Applicants attention to page 4 lines 1-14.

Applicant argues Sharrow does not disclose, teach, and/or fairly suggest "winding the coil under tension over the polymer jacket and heating the jacket so that the coil moves inward into the polymer jacket". The Examiner maintains Sharrow discloses (see paragraphs 36-38) "the coil (i.e. the reinforcing member) may be wrapped in a helical fashion by conventional winding techniques. The pitch of the adjacent turns of coil may be tightly wrapped" and "Reinforcing member…may be disposed over at least a portion of jacket… [and] may be partially or fully embedded within jacket 20. Embedding may be accomplished in a number of ways. For example, [reinforcing member] may be placed over a partially molten jacket 20 and then placing additional partially molten jacket 20 over [reinforcing member]". The Examiner notes that tightly wrapping a helical coil by conventional winding techniques winds a coil under tension. The Examiner notes that when the coil is placed over, wrapped in a helical fashion by conventional winding techniques over, a partially molten jacket, the coil moves inward into the polymer jacket.

Applicant argues Sharrow does not disclose, teach, and/or fairly suggest "winding the coil under tension over the polymer jacket and heating the polymer jacket so that tension within the coil is relieved". The Examiner maintains Sharrow discloses (see paragraphs 36-38, especially the sections reproduced above) "[The coil] can be disposed over jacket 20 and a heat shrink outer jacket or coating can be disposed over [the coil] 12 and the various structures can be thermally treated to embed braid in jacket 20". In addition the Examiner reiterates a section of the instant disclosure (see Specification pages 3-4), "The embedding process (which may be described as thermal embedding or tension embedding) may vary, but generally includes disposing coil 20 over jacket 18 and heating. For example, coil 20 can be embedded within jacket 18 by winding the coil wire over jacket 18 while under tension. The coiling tension may allow coil 20 to recover in wound diameter (i.e., "shrink" to the diameter that coil 20 would have if the tension was relieved) when jacket 18 is heated. Therefore, the diameter of coil 20 reduces as heat is applied (i.e., the tension within coil 20 is relieved) and coil 20 moves inward into jacket 18 as the outer surface of jacket 18 wicks and/or otherwise changes shape to conform to the inside surface of coil 20 (or take on some other shape). Thus, the shifting of coil 20 and the alteration of jacket 18 results in the embedding of coil 20 within jacket 18".

Applicant argues Sharrow does not disclose, teach, and/or fairly suggest "a coil including a central core material and an outer coating surrounding the central core material. The Examiner maintains Sharrow discloses (see paragraph 39) "The material of [coil] 12 can be blended with a liquid crystal polymer". The Examiner notes that when the coil material is blended with a liquid crystal polymer, the central core material has an outer coating surrounding the central core.

Applicant argues Sharrow does not disclose, teach, and/or fairly suggest "embedding the coil into the outer surface of the jacket in a manner that alters the shape of the outer surface of the jacket so that the outer surface of the jacket wicks outward between adjacent windings of the coil" and apparently rely upon a special definition of "embedding" set forth in the instant Specification.

The Examiner notes, in relying upon a special definition of "embedding", Applicant cites page 2 of the instant Specification, herein reproduced: "In some embodiments, coil 20 may be embedded within jacket 18. Being "embedded" within jacket 18 is understood to mean being disposed over jacket 18 in a manner that alters the shape of the outer surface of jacket 18. Thus, coil 20 is implanted or entrenched within jacket 18 and is not simply disposed on the top of jacket 18, completely submerged within jacket 18, or disposed between jacket 18 and another layer of material. Jacket 18 (in the absence of coil 20) may have or be manufactured to have a smooth outer surface. Embedding coil 20 into jacket 18 changes the shape of the outer surface as coil 20 is embedded therein. For example, embedding coil 20 into jacket 1 may result in jacket 18 wicking between the individual windings of coil 20. Accordingly, the shape of the outer surface of jacket 18 may be wave-like or otherwise include a series of peaks or alternating peaks and valleys. In some embodiments, this wave-like shape may generally conform to the shape of the inside surface of coil 20. The precise shape of the outer surface of jacket 18, however, may vary depending on a number of factors including the depth to which coil 20 is embedded. Figures 2-4 illustrate some examples of alternative shapes that may result".

The Examiner notes this paragraph of the Specification does appear to provide a special definition of "embedded" as it does positively recite "Being "embedded" within jacket 18 is understood to mean being disposed over jacket 18 in a manner that alters the shape of the outer surface of jacket 18." However the Examiner notes Applicant argues (see page 12 first paragraph filed 06/10/08) "As indicated in the present application, "embedding" is intended to mean that the "coil 20 is implanted or entrenched within jacket 18 and is not simply disposed on the top of jacket 18, completely submerged within jacket 18, or disposed between jacket 18 and another layer of material." Specification, at page 2, lines 16-21. Thus, Applicants have expressly indicated in the Specification what is intended by embedding the coil into the outer surface of the jacket. "Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim." M.P.E.P. §2111.01 IV, citing Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 53 USPQ2d 1065 (Fed. Cir. 1999)". The Examiner disagrees Applicant is entitled to the special definition of "embedded" as "coil 20 is implanted or entrenched within jacket 18 and is not simply disposed on the top of jacket 18, completely submerged within jacket 18, or disposed between jacket 18 and another layer of material." because it appears Applicant is relying upon a separate distinct sentence from that of the special definition. In addition, the Examiner notes should Applicant intend the scope of the claims to encompass "the coil is

implanted or entrenched within jacket and is not simply disposed on the top of jacket, completely submerged within jacket, or disposed between jacket and another layer of material". the claims should be amended to positively recite such.

The Examiner maintains Sharrow discloses "embedding", including the special definition thereof, the coil into the outer surface of the jacket in a manner that alters the shape of the outer surface of the jacket so that the outer surface of the jacket wicks outward between adjacent windings of the coil (see paragraph 37, reproduced in part above), "Reinforcing member…may be disposed over at least a portion of jacket… [and] may be partially or fully embedded within jacket 20".